UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,909	06/26/2003	Michael E. Leckrone	P-8030.03	5688

27581 7590 03/01/2006

MEDTRONIC, INC.
710 MEDTRONIC PARK
MINNEAPOLIS, MN 55432-9924

EXAMINER	
HO, UYEN T	
ART UNIT	**PAPER NUMBER**
3731	

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/606,909	LECKRONE ET AL.	
	Examiner	Art Unit	
	(Jackie) Tan-Uyen T. Ho	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 February 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *39,41 and 43-45* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *39,41 and 43-45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see Remarks, filed 2/15/06, have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Bonutti (6,187,023).

Specification

2. The disclosure is objected to because of the following informalities:

- Figures 31 and 32 were not described in Brief description and detailed description.
- Continuation data is not present in first paragraph of the specification.

Appropriate correction is required.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 39, 41, 43-45 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19, 39 and 40 of copending Application No. 10/606,908. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention of the present application encompasses the claimed invention of the application and the claimed invention of the application encompasses the claimed invention of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 39, 41, 43-45 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 23, 42 and 52 of copending Application No. 11/000,538. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention of the present application encompasses the claimed invention of the application and the claimed invention of the application encompasses the claimed invention of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 39, 41, 43-45 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-72 of copending Application No. 11/000539. Although the conflicting claims are not identical,

they are not patentably distinct from each other because the claimed invention of the present application encompasses the claimed invention of the application and the claimed invention of the application encompasses the claimed invention of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 39, 41, 43-45 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,613,062. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention of the present application encompasses the claimed invention of the patent and the claimed invention of the patent encompasses the claimed invention of the present application.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 39, 41, 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonutti (6,187,023) in view of Suzuki et al. (4,682,981). Bonutti discloses all the limitations of the claims (fig. 13, except that

- The Bonutti's flange is not frustoconical
- Bonutti's catheter system does not include a locking mechanism as claimed.

- Bonutti does not exclusively disclose the instrument inserted through an inner tube being a fluid delivery catheter.

Regarding the frustoconial shape, it would have been obvious matter of design choice to modify the flange of the Bonutti's apparatus to have a frustoconical shape since applicant has not disclosed that the flange with such specific shape solve any stated problem or is used for any particular purpose. One of ordinary skill in the art would have expected the Bonutti's apparatus and applicant's invention, to perform equally well with either shapes because both shapes of a flange would perform the same function equally well of stabilizing the apparatus at a target site.

A limitations of the claimed combination which presented no novel or unexpected result over a similar feature used in the prior art references, and solved no stated problem, was held to be an obvious matter of design choice within the skill of the art. In re Kuhle, 526 F2d 523; 188 USPQ 7 (CCPA 1975). In re Gazda, 42 CCPA 770; 219 F2d 449; 104 USPQ 400 (1955). In re Launder, 42 CCPA 886; 222 F2d 371; 10 USPQ 446 (1955).

Regarding the locking mechanism, although Bonutti does not disclose the locking mechanism as claimed, attention is directed to the Suzuki et al. reference which discloses the locking mechanism as claimed in order to preventing relative rotation of outer and inner tubs so that to simplify the insertion of the apparatus. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a locking mechanism in view of Suzuki et al. into the Bonutti's apparatus in order to simplify the insertion of the apparatus.

Regarding the fluid delivery catheter, it is well known in the art that other instruments beside a scope for treating the site as disclosed in Bonutti reference are

cannula for delivery drug or implant such cannula will meet all the structure limitations of a fluid delivery catheter. Therefore, it would have been obvious to one having ordinary skill in the art to use Bonuttti's apparatus in combination with other well-known cannula in the art in order to facilitate the entire treatment or operation percutaneously.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Jackie) Tan-Uyen T. Ho whose telephone number is 571-272-4696. The examiner can normally be reached on MULTIFLEX Mon. to Sat..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANHTUAN NGUYEN can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

(Jackie) Tan-Uyen T. Ho
Primary Examiner
Art Unit 3731

February 22, 2006

Enter
AA
2/23/06

REPLACEMENT SHEET

BEST AVAILABLE COPY

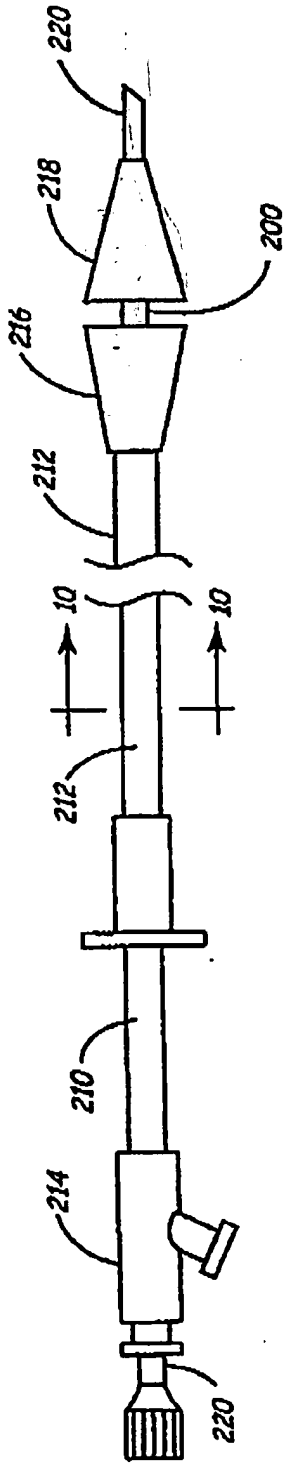

FIG. 9

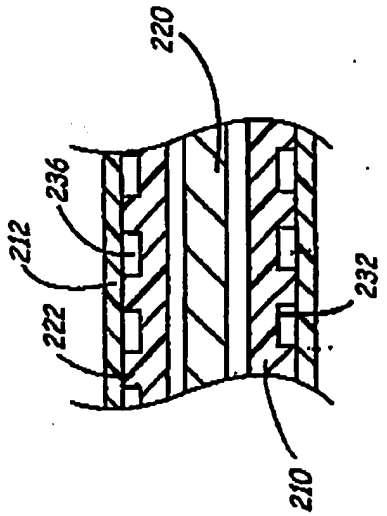

FIG. 11

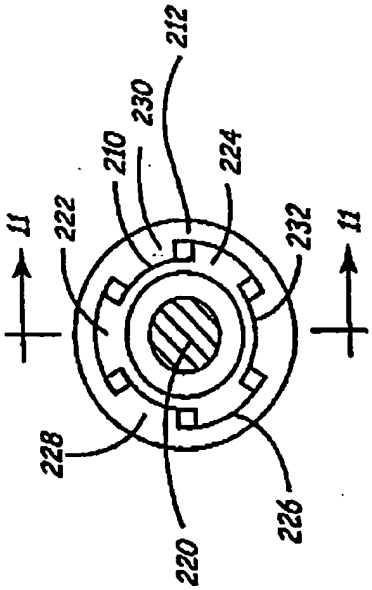

FIG. 10